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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,920	03/09/2004	Kenneth L. Levy	P0951	3347

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DIGIMARC CORPORATION
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EXAMINER
STANLEY, MARK P

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/797,920	LEVY, KENNETH L.
	Examiner	Art Unit	
	MARK P. STANLEY	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>28 February 2008</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,4,7-11 and 13-28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,4,7-11 and 13-28</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>09 March 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>11/26/2007</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____

DETAILED ACTION

1.   This action is in response to the amendment filed on 2/28/2008.

2.   Claims 1, 4, 7-11, and 13-28 are pending in the application. Claims 2-3, 5-

6, and 12 have been canceled. Claims 1, 4, 11, and 14 have been amended.

Claims 25-28 have been newly added.

Response to Arguments

3.   Applicant's arguments filed 2/28/2008 with respect to claims 1, 4, 7-11,

and 13-24 have been considered but are moot in view of the new ground(s) of

rejection.

        Applicant argues rejection relying on Roese failing to teach the use of

watermark data to determine tag information added to a packet header. The

examiner respectfully disagrees, where applicant states a watermark being a

transparent identifier inside a block of data used to determine various usage

rules of the data, paragraph [0116] of Roese states that the application

generating the data to be transmitted may determine the tag information where it

is implicitly taught that to determine the tag information when generating the data

the application generating the data must be able to extract information identifiers

for determining the usage rules to place as tag information in the header, where

for a user to determine their specific usage rules of the data the user must add

header tags on their own doing, hence the usage identifiers extracted by the

application from the data would be transparent to user as the user would not be

aware of them or be able to modify them directly and must independently create

any of the users desired usage rules. Therefore, Roese does teach the use of a tag placed in a header where the tag is determined by a transparent identifier inside the block of data.

Applicant argues that Roese does not teach "said domain comprises networked devices associated with a single family". The examiner respectfully disagrees, where applicant describes a in [0024] of their specification, a single family is taken to be no more than a single entity of which devices belongs to. In paragraph [0115] of Roese, any devices that belong to a single entity such as a campus regardless of who uses the devices belonging to the single entity constitutes as a domain of network devices associated with a single family where the restrictions on the exchanging the content may be limited to within the domain of the single family such as a campus or completely prohibited at all from exchanging. Therefore, Roese does teach use of a domain comprising networked devices associated with a single family.

Applicant argues that Roese teaches one state where data is tagged and prohibited from transmissions to certain destinations and does not a teach transmission to any destination is prohibited. The examiner respectfully disagrees, where paragraph [0115] of Roese states "defined boundaries (e.g., a present device, a room, ..." where the tag incorporates both states being that the tag may prohibit transmissions to certain destinations or prohibit transmissions to any destination that is outside present device meaning transmissions to any location from the present device is prohibited. Therefore, Roese does teach a state which prohibits transmissions to any destination.

Applicant argues that Roese does not teach the use of a "content identifier" as described by application. The examiner respectfully disagrees, in paragraph [0116] Roese states a content identifier (information pertaining to determining geographical boundaries) is obtained from the first portion (data placed in the body of the packet) used in the second portion (as a tag indicating geographical boundaries in the header of the packet). Therefore, Roese does teach the use of a "content identifier" obtained from the data placed in the first portion and placing the identifier in the second portion.

Applicant argues Moskowitz does not teach the use of a "content identifier" with a watermark. The examiner respectfully disagrees, col. 10 lines 23-24 and col. 7 lines 29-60 of Moskowitz states the packet watermark in the header is used for determining identity and authentication information of the packet including the body contents of the packet and is used for bandwidth determination and billing during transmission and further teaches the use of digital and software watermarking in col. 9 where a packet watermark acts no differently than a digital or software watermark, as it is simply use to identify usage rules of the packet including the body being transmitted and acts transparently. Furthermore as described previously, Roese is shown to teach the use of a "content identifier" properly regardless of being combined with the teachings of Moskowitz.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States
> before the invention by the applicant for patent; or (2) a patent granted on an application for patent
> by another filed in the United States before the invention by the applicant for patent, *except* that an
> international application filed under the treaty defined in section 351(a) shall have the effects for the
> purposes of this subsection of an application filed in the United States only if the international
> application designated the United States and was published under Article 21(2) of such treaty in the
> English.

5.   Claims 1, 4, 7-11, and 13-24 are rejected under 35 U.S.C. 102(e) as being

anticipated by Roese et al. (US 2003/0217122 A1 hereinafter Roese).

      Regarding claim 1, Roese discloses "a method of enforcing geographical

restrictions on content redistribution in a TCP/IP network, an improvement

comprising defining a geographical boundary across which certain content does

not pass, wherein said boundary is defined--at least in part--by a hardware

firewall device" ([0098], [0115]-[0118], Fig. 6, where [0098] describes the use of

firewalls with devices sending and receiving content information, [0117]

describes preventing the data from being transmitted at the point of transmission

or at the point of reception depending on assigned restrictions of the data).

      "determining whether an IP packet should be regarded as conveying

content that should not cross said boundary, by reference to flag bits included in

the header of said packet" ([0115]-[0118], Fig. 6, where step 620 in Fig. 6 is

where data being transmitted is tagged with information about a boundary

restriction, and [0116] describes the tagged information being a flag in the header of the data packets being transmitted).

"wherein said flag bits are related to the payload of a watermark in the content" ([0115], [0117], [0115] describes the location limitations of the data being transmitted as a result of the sensitivity of the data that is being transmitted, thus it is inherent the flag bits in the header that restricts the transfer of the sensitive data is dependent on the sensitivity of the body data).

Regarding claim 4, Roese discloses "a method of data processing that includes forming an IP packet having header data and body data, wherein the header data includes a first destination address, the method comprising:

forming said header data to additionally include additional data specifying whether it is permissible to send a copy of data in the packet to a second destination address, wherein the additional data has at least two states~ respectively indicating:

(a) it is not permissible to send a copy of data in the packet to any second destination address;" ([0115], Fig. 1, where paragraph [0115] of Roese states "defined boundaries (e.g., a present device, a room, ..." where the tag incorporates both states being that the tag may prohibit transmissions to certain destinations or prohibit transmissions to any destination that is outside present device meaning transmissions to any location from the present device is prohibited. Therefore, Roese does teach a state which prohibits transmissions to any destination) or (b) it is not permissible to send a copy of data in the packet to

any second destination address except to a second destination address within a domain that also includes the first destination address" ([0115]-[0118], Fig. 6, describes preventing the data from being sent to any other destination, [0117] describes selectively preventing data from being sent to any destination outside of a set domain, [0115] describes a device may not transmit data to any other destination outside a domain, it is inherent that no device may be authorized to receive the content no matter the device location).

"the method of claim 5 wherein said domain comprises networked devices associated with a single family" ([0115], any devices that belong to a single entity such as a campus regardless of who uses the devices belonging to the single entity constitutes as a domain of network devices associated with a single family where the restrictions on the exchanging the content may be limited to within the domain of the single family such as any network devices within a campus)

Regarding claim 7, Roese discloses "the method of claim 4 wherein a device associated with the first destination address has a first physical location and a device associated with the second destination address has a second physical location, and the additional data includes a field signaling that copying of data in said packet to said second destination address should be:

(a) permitted if the second physical location is physically proximate to the first physical location; and

(b) prohibited if the second physical location is physically remote from the first physical location" ([0100]-[0103] describes the location limitation being a physical location limitation)

Regarding claim 8, Roese discloses "the method of claim 7 wherein the first and second destination addresses are within a common domain" ([0100]-[0103], Fig. 1, Fig. 8, where the first and second destination devices can be within a common domain).

Regarding claim 9, Roese discloses "the method of claim 7 wherein the first and second destination addresses both correspond to network devices associated with a single family" ([0100]-[0103], Fig. 1, Fig. 8, network devices allowed within the network may be limited to a single family).

Regarding claim 10, Roese discloses "the method of claim 4 wherein said additional data is related to the payload of a watermark encoded in the body data" ([0115], [0117], [0115] describes the location limitations of the data being transmitted as a result of the sensitivity of the data that is being transmitted, thus it is inherent the additional data in the header that restricts the transfer of the sensitive data is dependent on the body data, [0117] states that the data itself that is transmitted can contain authentication rules on itself, thus the body data can contain watermark information).

Regarding claim 11, the claim is rejected for the same reasons as claim 4 above.

Regarding claim 13, the claim is rejected for the same reasons as claim 4 above.

Regarding claim 14, the claim is rejected for the same reasons as claim 7 above.

Regarding claim 15, the claim is rejected for the same reasons as claim 8 above.

Regarding claim 16, the claim is rejected for the same reasons as claim 9 above.

Regarding claim 17, Roese discloses "the method of claim 14 wherein the method includes determining whether the second physical location is physically remote from the first physically location by reference to whether the second destination address is served by a common firewall with the first destination address ([0098] describes combining the use of a firewall with the physical locations of the devices, where it states a firewall makes determination of packets into and out of a network).

Regarding claim 18, the claim is rejected for the same reasons as claim

10 above.

Regarding claim 19, the claim is rejected for the same reasons as claim

4 above.

Regarding claim 20, the claim is rejected for the same reasons as claim

4 above.

Regarding claim 24, the claim is rejected for the same reasons as claim

4 above.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

7.   Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Roese et al. (US 2003/0217122 A1 hereinafter Roese) in view of Moskowitz

(US 7,287,275 B2 hereinafter Moskowitz).

Regarding claim 21-23, Roese teaches the use of tags placed in a

header information with packets for restricting distribution of data between

devices based on network access regulations with the use of firewalls and physical location of the devices where the tag is generated based on the data to be transmitted where the tag would further identify the content through a geographical limitation identifier in the header. But, Roese does not explicitly state the content identification information in the header of the packet to more particularly or uniquely identify the content where a table of file allocation is used.

However, Moskowitz teaches the using of transmitting streams of content through the use of packets (col. 4, lines 35-67), where the header contains watermark information for related to the content of the packet for authentication during transmission of the packet (col. 4, lines 55-57) and storing data in the form of packets in a storage medium with content identification (col. 5, lines 56-62, Official Notice is taken that data broken into blocks of information and then stored in a medium must be associated by some means for reconstruction, the use of an allocation table would have been obvious to one of ordinary skill in the art at the time of the invention). One of ordinary skill in the art at the time of the invention would have been motivated to modify the teachings of Roese with that of Moskowitz to better restrict and identify content being transmitted through a network.

8.   Claims 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roese et al. (US 2003/0217122 A1 hereinafter Roese) in view of Levy (US 2001/0044899 hereinafter '899).

Regarding claims 25-26 and 28, Roese discloses packetizing data and
adding geographical limitations in the form of tags to the header of the packets
based on the data being packetized ([0115]-[0118]). But, Roese does not
explicitly state the data being <u>video entertainment data</u> where the video
entertainment data includes header data or digital watermarks hidden <u>in the
video entertainment data.</u>

However, '899 discloses transmarking video entertainment data to be
preserve the use of a video entertainment data digital watermark when modifying
the signal of the video entertainment data including packetizing the video
entertainment data ([0012]-[0013], [0015]). Where information pertaining to the
video entertainment data digital watermark is placed into the header of the
packet ([0035]) to preserve the watermark during transmission and for re-
combing the data and watermark properly. Additionally, '899 discloses
transmarking including converting <u>a header of the video entertainment data</u> into a
watermark ([0016]) where '899 previously discloses placing information
pertaining to the watermark into the header of the packet this would now
effectively teach placing information pertaining to a header of the video
entertainment data into the header of the packet by transmarking the header of
the video entertainment data into a watermark beforehand.

Therefore, it would have been obvious to a person of ordinary skill in the
art at the time the invention was made to combine the teachings of '899 for
preserving watermark and header information of a video entertainment data by
placing information pertaining to the watermark and header data into the packet

header with the teachings of Roese for placing tag information into the header of

the packet based on the data packetized to enforce geographical limitations on

exchanging the data. One would have been motivated to do so to further improve

the range of data type capabilities for transfer where Roese suggests the data

type including video information ([0004])

9.   Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Roese et al. (US 2003/0217122 A1 hereinafter Roese) in view of Levy (US

2001/0044899 hereinafter '899) and in further view of Levy et al. (US

2002/0186844 hereinafter '844).

        Regarding claim 27, Roese and '899 teach claim 25 as disclosed above,

but do not explicitly teach obtaining restriction information from a remote

repository. However, '844 states the use of obtaining a content identifier from a

video entertainment data digital watermark using the content identifier to retreive

usage restrictions imposed on the video entertainment data from an external

database ([0025]-[0026], Fig. 1). Therefore, it would have been obvious to a

person of ordinary skill in the art at the time the invention was made to combine

the teachings of '844 for obtaining restriction information from a remote

repository associated with the video entertainment data via a content identifier

determined by the digital watermark with the teachings of Roese and '844 where

restriction information based on data to be transmitted imposing geographical

limitations is placed in the header of a packet. One would have been motivated to

do so to further improved the teachings of '844 for using a digital watermark

embedded in video entertainment data whereby accessing restriction information pertaining to the digital watermark that may not have been entirely contained within the digital watermark so as to provide a option of updating of the restriction information a remote database.

Response to Arguments

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contacts

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK P. STANLEY whose telephone number is (571)270-3757. The examiner can normally be reached on 8:00AM - 5:00PM Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark P Stanley/
Examiner, Art Unit 2623

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2623